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EXAMINER

BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 02/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/055,968

Applicant(s)

KOSINSKI ET AL.

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspond nc address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2003 and 07 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-69 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-69 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 19 August 2003 and the supplemental amendment filed 7 November 2003. Claims 1-69 are pending. Claims 1, 9, 18, 27-29, 37-40, 46, 56-60, 64, and 65 have been amended. Claims 66-69 are newly added. No claims have been cancelled.

Claim Rejections - 35 USC § 101

2. The rejection of claims 43-53 under 35 USC 101 is hereby withdrawn due to the response filed 19 August 2003.

Specification

3. The amendment filed 19 August 2003 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The newly added step of "independently assessing by at least one of a pharmacist associated with the prescription processing system correctness of the prescription request, the at least one of the pharmacist and personnel and the prescription processing system being separate from at least one of a hospital and a physician where the prescription request was originated, and the at least one of the

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pharmacist and personnel and the prescription processing system being separate from a central pharmacy where the prescription request is to be fulfilled” within claims 65, 67, 68, and 69 appears to constitute new matter. In particular, Applicant does not point to, nor was the Examiner able to find any support for the newly added step discussed above within the specification as originally filed. As such, Applicant is respectfully requested to clarify the above issues and to specifically point out support for the newly added limitations in the originally filed specification and claims.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Objections

4. Claim 46, lines 5-7, is objected to because of the following informalities: namely “wherein said submitted prescription is digitized into said digitized prescription request, and transcribing said general information...” appears to be grammatically incorrect. Appropriate correction or clarification is requested.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) Claim 18, line 6, "existing prescription number" lacks proper antecedent basis. For purposes of applying prior art, "existing prescription number" is being interpreted as "existing unique prescription number".

Claim Rejections - 35 USC § 112

7. Claims 65 and 67-69 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention and for the reasons set forth in the objection to the specification above.

Independent claims 65 and 67-69 recite limitations that are new matter, as discussed above.

NOTE: The following rejections assume that the subject matter added in 7 November 2003 amendment are NOT new matter, and are provided hereinbelow for Applicant's consideration, on the condition that Applicant properly traverses the new matter objections and rejections made in preceding sections above in the next communication sent in response to the present Office Action.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-17, 24-27, 30-36, 37-45, 47-53, and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albaum et al. (5,758,095) in view of Walker et al. (5,883,370), for substantially the same reasons given in the previous Office Action (paper number 5), and further in view of Simcox (5,992,890).

(A) Claim 1 has been amended to recite the step of "independently assessing by personnel associated with the prescription processing system correctness of the prescription request".

The collective teachings of Albaum and Walker fail to expressly disclose "independently assessing by personnel associated with the prescription processing system correctness of the prescription request". However, such a feature is suggested by Albaum by the disclosure of requiring a physician to countersign orders electronically and upon sending a prescription refill, having the authorization for the prescription verified (col. 15 lines 33-49, col. 18 lines 1-6). It is noted that typically "countersigning" an order for a prescription would include the physician viewing the order to determine whether or not it is a proper order before the physician signs the order.

Simcox discloses system where a prescriber transmits a prescription to a computer either within the prescribers office or at the point of pharmaceutical distribution (col. 4 lines 21-40 and col. 5 lines 1-25). Further Simcox discloses upon a pharmacist receiving the completed prescription, the pharmacist interpreting the pharmaceutical identification and confirming this interpretation by correlating the specific

pharmaceutical identified in the pharmaceutical identification section with the application being identified in a graphical indicia section, and then in the event that the pharmaceutical identified does not serve the purpose illustrated by the selected graphical icon, the pharmacist immediately knows that the pharmaceutical is incorrect, wherein the graphical icons are classes of pharmaceuticals such as Cough/Cold, respiratory/lung disorders, etc.) (col. 3 line 65 to col. 4 line 8, col. 4 lines 21-40 and col. 5 lines 1-25).

At the time the invention was made, it would have been obvious to combine the features of Simcox within the method taught collectively by Albaum and Walker with the motivation of preventing a pharmaceutical from being dispensed that is incorrect, thus preventing a potentially dangerous situation for a patient (Simcox; col. 4 lines 21-40).

The remaining features of claim 1 are rejected for the same reasons set forth in the previous Office Action, and incorporated herein (paper number 5; section 5A; pages 3-6).

(B) Claims 2-8, 10-12, 13-14, 15-16, 17, 24-26, 30-33, and 34-36 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 5; section 5; pages 6-20).

(C) Claim 9 has been amended to include converting the captured prescription request to a digitized format "at the prescription processing system" to obtain a digitized prescription request.

As per this limitation, Albaum discloses performing an order recognition function by an order reformatter and interpreter to check for recognition of the doses, route of administration, frequency, and duration, wherein the order information received by the order reformatter and interpreter when entered by the user is entered in random sequence and then processed, wherein the inpatient module (reads on "prescription processing system") performs processing functions and is connected to a user interface which accepts input via keyboard and mouse, voice recognition, or pen interface (reads on "capturing..." and "converting...") (Fig. 49e and 49f, col. 7 lines 25-30, col. 11 lines 4-13, col. 20 line 40 to col. 21 line 33). Further, Albaum discloses the inpatient module performing all of the primary processing function represented by the order reformatter and interpreter, including voice recognition, which would include converting voice to digital data (col. 7 lines 25-30).

(D) Claim 27 has been amended to include the step of "printing" a form pre-populated with the verified information. Simcox discloses verifying a prescription and then printing a copy of the completed prescription medium (col. 5 lines 1-25). The motivation for combining Simcox within the method taught collectively by Albaum and Walker is given above in claim 1, and incorporated herein.

(E) The amendments to claims 37-40 reflect the same changes made to claim 1, discussed above, and are therefore rejected for the same reasons given above for claim

1 in addition to the rejections made for claims 37-40 and 56-64 in the prior Office Action (paper number 5; section 5; pages 6-20).

(F) Claims 41-45 and 47-53 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 5; section 5; pages 6-20).

(G) As per claim 55, Albaum discloses the inpatient module performs processing functions and is connected to a user interface which accepts input via keyboard and mouse, voice recognition, or pen interface (Fig. 49e and 49f, col. 7 lines 25-30, col. 11 lines 4-13, col. 20 line 40 to col. 21 line 33). Further, Albaum discloses the inpatient module performing all of the primary processing function represented by the order reformatter and interpreter, including voice recognition, which would include converting voice to digital data (col. 7 lines 25-30).

10. Claims 18-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albaum et al. (5,758,095) in view of Walker et al. (5,883,370), for substantially the same reasons given in the previous Office Action (paper number 5), and further in view of Simcox (5,992,890) as applied to claim 1 above, and further in view of Rhodes et al. (5,666,492).

(A) Claim 18 has been amended to recite the step of determining if there is an existing “unique” prescription number for renewal and requesting the existing prescription number if it is available.

Albaum and Walker fail to disclose determining if there is an existing “unique” prescription number for renewal and requesting the existing prescription number if it is available.

Rhodes discloses determining if the prescription number entered by the user is a valid prescription number (i.e., “0000004”) by comparing the prescription number against those stored in the data storage device, and if the prescription number is valid, displaying basic information relating to the prescription number, wherein the user enters the prescription number through a Refill RX screen, and wherein the system automatically finds the patient associated with the prescription number needing a refill (Fig. 26, 45-47, col. 17 line 18 to col. 18 line 47, col. 28 line 15 to col. 29 line 20, col. 30 lines 45-58). It is noted that the “prescription number” of Rhodes is “unique” because the Rhodes system retrieves a single patient associated with the single prescription number.

At the time the invention was made, it would have been obvious to include the features of Rhodes within the method taught collectively by Albaum and Walker with the motivation of reducing the amount of time from when an order for a prescription is written to when it is received in the pharmacy (Albaum; col. 1 lines 30-36).

(B) As per claims 19-21, Albaum discloses a database containing health and medication information regarding medications and a patient, and a means for alerting the user to potentially adverse situations as a result of the prescribed medications, based on information in the database, wherein the adverse situation is an allergic reaction to the prescribed medication, wherein the adverse reaction is an interaction between two or more prescribed medications (col. 13 lines 44-65, col. 18 lines 1-6, col. 21 lines 34-45, col. 22 lines 29-50). Further, Albaum discloses the database storing ongoing lab data with respect to a patient, wherein a message is displayed to the user to recommend drug changes based on ongoing lab data, wherein a means for permitting the user to modify the prescribed medications based on the information, such as the lab data displayed to user, wherein modification includes entering accepting at least one medication identifier (col. 13 lines 44-65, col. 18 lines 1-68, col. 20 lines 40-68, col. 21 lines 34-45, col. 22 lines 29-50). Albaum includes countersigning the prescription order electronically by a physician, processing the order immediately, and then closing the ordering screen (col. 13 lines 44-65, col. 18 lines 1-6, col. 21 lines 34-45, col. 22 lines 29-50). Also, Albaum includes screen selections available to the physician for requesting special treatment authorization for non-formulary drugs, and if the user does not authorize the drugs, the order is cancelled (col. 16 lines 20-47, col. 18 lines 1-6, col. 20 lines 10-15).

(C) As per claims 22-23, Albaum discloses entering into a user interface a patient identifier for a patient, wherein the identifier includes the patient's name, patient's

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location, or ID number, wherein patient demographic data such as name, address, telephone number, date of birth, sex, diagnosis, allergies, height, weight, medical folder/record number, and insurance plan are collected through a patient information database (Fig. 2-9, col. 15 lines 49-55 and col. 21 lines 1-15) and accepting and processing information regarding medication prescriptions for a patient, wherein the information includes a medication identifier, medication dosage, medication frequency, medication duration, medication quantity, maximum dosage recommended for a patient (col. 20 lines 41-68).

11. Claim 28 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albaum et al. (5,758,095) in view of Walker et al. (5,883,370), for substantially the same reasons given in the previous Office Action (paper number 5), and further in view of Simcox (5,992,890) as applied to claim 1 above, and further in view of Bartur (6,263,259).

(A) Claim 28 has been amended to include the step of comparing "at the prescription processing system" a physician's phone number and a prescription number, and if the physician's phone number and the prescription number result in a predetermined relationship, "wherein the predetermined relationship is a match between the physician's phone number and the prescription number and a stored physician's phone number and a stored prescription number stored at the prescription processing system"

then filling the prescription request using an automated entry agent "associated with the prescription processing system".

Albaum and Walker fail to expressly disclose these newly added limitations.

However, Albaum suggests the step of verifying who a user's identity by disclosing an inpatient module performing all of the primary processing function represented by the order reformatter and interpreter (col. 7 lines 25-30) and requiring a physician to countersign orders electronically and upon sending a prescription refill, having the authorization for the prescription verified (col. 15 lines 33-49, col. 18 lines 1-6).

Bartur discloses verifying by a database a patient ID, physician ID, and medication ID by matching the patient ID, physician ID, and medication ID with stored IDs in the database, wherein if the IDs are verified, the prescription is dispensed by a medication unit dispensing stored medications (Abstract; col. 11 lines 30-50, col. 13 line 49 to col. 14 line 44).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Bartur within the method taught collectively by Albaum, Walker, and Simcox with the motivation of preventing a pharmaceutical from being dispensed that is incorrect, thus preventing a potentially dangerous situation for a patient (Simcox; col. 4 lines 21-40).

As per the recitation of a "physician's phone number", it is noted that Bartur's Physician ID may include a physician's phone number as the ID. It would have been obvious within the method taught collectively by Albaum, Walker, Simcox, and Bartur to

include using a phone number with the motivation of providing a physician with an identifier that is easy to remember.

(B) As per claim 66, Bartur discloses if an ID cannot be verified, contacting the system administrator to indicate a problem (Abstract; col. 11 lines 30-50, col. 13 line 49 to col. 14 line 44). It is respectfully submitted that contacting the system administrator regarding a problem would typically include examining the problem to determine whether the information was a valid, correct identifier. The motivation being to ensure security of patient information.

12. Claims 29, 54, and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albaum et al. (5,758,095) in view of Walker et al. (5,883,370), for substantially the same reasons given in the previous Office Action (paper number 5), and further in view of Simcox (5,992,890) as applied to claims 1 and 43 above, and further in view of Munoz et al. (US 2002/0052760).

(A) Claim 29 has been amended to recite step of establishing a connection using a telephone "and wherein the step of submitting includes communicating with the prescription processing system using a touch tone telephone keypad" and claim 54 has been added to recite "the prescription request being submitted telephonically" and

Albaum and Walker do not expressly disclose "the prescription request being submitted telephonically" and establishing a connection using a telephone "and wherein

the step of submitting includes communicating with the prescription processing system using a touch tone telephone keypad.” However, Albaum suggest using voice recognition to input data (col. 7 lines 25-30).

Munoz discloses an IVR (interactive voice response) system for detecting incoming telephone calls, answering the telephone call, and providing the caller with various input prompts, wherein the caller provides input by pressing buttons on a DTMF telephone during the call, and wherein the system is utilized for creating a prescription requests and refills (Fig. 1, par. 38-39, par. 43-48, page 8 claims 1-5).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Munoz within the method taught collectively by Albaum, Walker, and Simcox with the motivation of allowing a user to quickly interact with a prescription system by the system automatically answering the telephone call and beginning to interact with the user (Munoz; par. 4) and to provide a system for users who may not have a computer to input information, thus increasing the number of users of the system.

(B) Claim 63 repeats the limitations of claims 29 and 54, and is therefore rejected for the same reasons given for those claims, and incorporated herein.

13. Claim **46** are rejected under 35 U.S.C. 103(a) as being unpatentable over Albaum et al. (5,758,095) in view of Walker et al. (5,883,370), for substantially the same reasons given in the previous Office Action (paper number 5), and further in view of

Simcox (5,992,890) as applied to claims 43 above, and further in view of Johnson et al. (5,664,109).

(A) Claim 46 has been amended to include a header entry agent for retrieving general information from a digitized prescription request, wherein said submitted prescription is digitized into said digitized prescription request, and transcribing said general information wherein general information comprises non-medication related information comprising at least one of member's name, member's identification number, physician information, and patient information.

Albaum and Walker fail to disclose a header entry agent for retrieving general information from a digitized prescription request, wherein said submitted prescription is digitized into said digitized prescription request, and transcribing said general information wherein general information comprises non-medication related information comprising at least one of member's name, member's identification number, physician information, and patient information.

Johnson discloses extracting medically relevant information and demographic information using a batch extraction program from an OCR file (reads on "retrieving..." step) and creating a new medical service record associated with the medically relevant information and demographic information and populating the data fields of a new medical service record with the extracted pre-defined data, wherein the file includes demographic information, such as a patient's name and social security number, medical

prescriptions (reads on "transcribing..." step) (Fig. 7, col. 6 line 44 to col. 7 line 57, col. 13 lines 1-27, col. 15 lines 5-20, col. 15 line 45 to col. 18 line 17).

As per the recitation of "a prescription request", the methods disclosed by Albaum in claim 1 are incorporated herein regarding a method for inputting prescription requests.

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Johnson within the method taught collectively by Albaum, Walker, and Simcox with the motivation of allowing members of health care organizations to submit data using different medical formats, hardware, and software, thus the members do not have significant extra cost or overhead when using the system (Johnson; col. 2 lines 26-37).

14. Claims **56- 60 and 64-65** are rejected under 35 U.S.C. 103(a) as being unpatentable over Albaum et al. (5,758,095) in view of Walker et al. (5,883,370), Munoz et al. (US 2002/0052760), and Simcox (5,992,890). It is noted that these newly added claims appear to be combinations of limitations that were presented in independent claims 1 and 37-43 and dependent claims 2-36 and 44-53, and newly added claims 54-55, 63, and 66. These limitations were addressed in the previous Office Action (paper number 5) and in the rejections of claims 1-53 and newly added claims 54-55, 63, and 66 above, and are incorporated herein.

(A) As per claims 56-58, Albaum discloses a method for prescribing medication for a patient comprising (col. 20 lines 40-43):

(a) signing onto a hospital pharmacy module or an outpatient/clinic module of an interactive medication ordering system by entering a user's ID (sign-on code) through a user interface over a communication network, wherein the user interface is used to communicate with an off-site location through the interactive medication ordering system (reads on "remotely") (Fig. 1 and 49a, col. 1 lines 5-13, col. 6 line 23 to col. 4 line 30, col. 16 lines 10-20, col. 17 lines 40-60);

(b) entering a new order for a prescription using voice entry, wherein the order includes information related to at least one medication identifier, the patient's name, the patient's bed number, the patient's medical record number, the maximum dosage recommended for a patient (Fig. 49c, 49i, col. 3 lines 1-3, col. 6 lines 34-40, col. 7 line 65 to col. 8 line 11, col. 20 line 40 to col. 21 line 33);

(c) performing an order recognition function by an order reformatter and interpreter to check for recognition of the doses, route of administration, frequency, and duration, wherein the order information received by the order reformatter and interpreter when entered by the user is entered in random sequence and then processed, wherein the inpatient module performs processing functions and is connected to the user interface which accepts input via keyboard and mouse, voice recognition, or pen interface (reads on "capturing..." and "converting...") (Fig. 49e and 49f, col. 7 lines 25-30, col. 11 lines 4-13, col. 20 line 40 to col. 21 line 33);

(d) providing a database containing health and medication information regarding a patient, wherein the information is stored as patient records, wherein a patient record includes information such as medication ordered, dosage, frequency, medication quantity and formulary, wherein a user may edit a current or active medication order, wherein a patient's medication profile contains the patient's name, bed number, medical record number, list of patient's current schedule and PRN medications (Fig. 33, col. 8 lines 12-20, col. 10 lines 17-60, col. 17 lines 15-35, col. 18 lines 63-67, col. 20 line 40 to col. 21 line 33);

(e) interpreting and reformatting the orders for processing (reads on "transcribing...") (col. 3 lines 15-20); and

(f) automatically transmitting and printing in the pharmacy the written or typed order by a physician based on the interpreted and reformatted orders, wherein the physician is able to electronically counter sign the patient's order and is alerted to potentially adverse situations such as drug reactions, wherein the pharmacy is a pre-existing hospital pharmacy (reads on "central pharmacy" or "filling pharmacy") or retail pharmacy (reads on "filling pharmacy") (reads on "preparing..." and "sending...") (Fig. 1, col. 3 lines 15-20, col. 7 lines 25-40, col. 8 lines 43-63, col. 15 lines 12-32, col. 18 lines 1-6, col. 20 line 40 to col. 21 line 45).

Albaum fails to expressly disclose sending "a completed prescription form" to a central pharmacy, and then filling the prescription request at the central pharmacy, based at least partially on the completed prescription form.

Walker includes printing out a prescription slip (Fig. 6) with a prescription bar code which contains pertinent prescription information to enable filling of the prescription, taking the prescription slip to a pharmacist by the patient, and having the pharmacist fill the prescription by scanning the prescription bar code on the prescription slip to obtain the pertinent information (Figure 3, col. 5 line 55 to col. 6 line 7).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the aforementioned components with the method of Albaum with the motivation of reducing the time from when the order is written to when it is received in the pharmacy (Albaum; col. 1 lines 30-36), reducing the efficiencies due to slow and cumbersome medication ordering paths by reducing the paperwork and task duplication (Albaum; col. 1 line 63 to col. 2 line 10), providing a system which is less rigid and easier to use for physicians (col. 2 line 45-50), and reducing the number of errors in prescribing medications (Walker; col. 1 lines 25-30).

In addition, it is noted that Albaum's database stores patient medical information including patient medications as patient records, wherein the medications are entered in the patient medication profile (Fig. 33, col. 8 lines 12-20, col. 10 lines 17-60, col. 17 lines 15-35, col. 18 lines 63-67, col. 20 line 40 to col. 21 line 33). Therefore, Albaum's entering of information in a database is considered to be a form of associating or concatenating "an identification file" with "a prescription file."

Albaum and Walker do not expressly disclose establishing a connection using a telephone and submitting an audible prescription request using a telephone. However,

Albaum suggest using voice recognition to input data (col. 7 lines 25-30) (reads on “audible prescription request”. Note the discussion above at step c.

Munoz discloses an IVR (interactive voice response) system for detecting incoming telephone calls, answering the telephone call, and providing the caller with various input prompts, wherein the system is utilized for creating a prescription requests and refills (Fig. 1, par. 38-39, par. 43-48, page 8 claims 1-5).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the telephonic features of Munoz within the method taught collectively by Albaum and Walker with the motivation of allowing a user to quickly interact with a prescription system by the system automatically answering the telephone call and beginning to interact with the user (Munoz; par. 4) and to provide a system for users who may not have a computer to input information, thus increasing the number of users of the system.

The collective teachings of Albaum, Walker, and Munoz fail to expressly disclose “independently assessing by personnel associated with the prescription processing system correctness of the prescription request”. However, such a feature is suggested by Albaum by the disclosure of requiring a physician to countersign orders electronically and upon sending a prescription refill, having the authorization for the prescription verified (col. 15 lines 33-49, col. 18 lines 1-6). It is noted that typically “countersigning” an order for a prescription would include the physician viewing the order to determine whether or not it is a proper order before the physician signs the order.

Simcox discloses system where a prescriber transmits a prescription to a computer either within the prescribers office or at the point of pharmaceutical distribution (col. 4 lines 21-40 and col. 5 lines 1-25). Further Simcox discloses upon a pharmacist receiving the completed prescription, the pharmacist interpreting the pharmaceutical identification and confirming this interpretation by correlating the specific pharmaceutical identified in the pharmaceutical identification section with the application being identified in a graphical indicia section, and then in the event that the pharmaceutical identified does not serve the purpose illustrated by the selected graphical icon, the pharmacist immediately knows that the pharmaceutical is incorrect, wherein the graphical icons are classes of pharmaceuticals such as Cough/Cold, respiratory/lung disorders, etc.) (col. 3 line 65 to col. 4 line 8, col. 4 lines 21-40 and col. 5 lines 1-25).

At the time the invention was made, it would have been obvious to combine the features of Simcox within the method taught collectively by Albaum, Walker, and Munoz with the motivation of preventing a pharmaceutical from being dispensed that is incorrect, thus preventing a potentially dangerous situation for a patient (Simcox; col. 4 lines 21-40).

As per the recitation of "converting the digitized prescription request to a digitized format to obtain a digitized prescription request," Albaum discloses performing an order recognition function by an order reformatter and interpreter to check for recognition of the doses, route of administration, frequency, and duration, wherein the order information received by the order reformatter and interpreter when entered by the user

is entered in random sequence and then processed, wherein the inpatient module (reads on "prescription processing system") performs processing functions and is connected to a user interface which accepts input via keyboard and mouse, voice recognition, or pen interface (reads on "capturing..." and "converting...") (Fig. 49e and 49f, col. 7 lines 25-30, col. 11 lines 4-13, col. 20 line 40 to col. 21 line 33). Further, Albaum discloses the inpatient module performing all of the primary processing function represented by the order reformatter and interpreter, including voice recognition, which would include converting voice to digital data (col. 7 lines 25-30).

(B) Claim 59 differs from claims 56-58, above, by reciting the steps of: determining if the user would like to submit a new prescription request, repeat the steps of submitting, capturing, transcribing, preparing, sending, filling, and determining if the user would like to submit a new prescription request, and terminating the connection if the user would not like to submit a new prescription request. As per these steps, Albaum discloses:

(a) allowing a user to sign onto the hospital pharmacy module or the outpatient/clinic module using a user's ID to enter a new order for medication, wherein the option to enter a new prescription order is done through an interface by pressing a "new" button (see Figure 9) (Fig. 49c, col. 17 lines 40-60, col. 18 lines 24-35);

(b) entering a new medication order completely (medication and directions for administration), wherein new medication orders are listed in the present actions list and may be processed at anytime before another patient is selected or before the user signs off the system (Fig. 49c, 49g, col. 18 lines 24-35); and

(c) closing the ordering screen and beginning order processing if the user has completed the orders (Fig. 29, col. 13 lines 44-54).

Note, the process for entering another prescription request is the same as the process for entering a first prescription as was discussed above in the rejections of claims 56-58, and further disclosed in Albaum (see Figure 49g-49j).

The remainder of claim 59 repeats the same limitations as claims 56-58, and is rejected for the same reasons given for those claims, and incorporated herein.

(C) Claim 60 differs from claims 56-59 by reciting "wherein the audible prescription request includes user information and a member ID." Munoz teaches entering the social security number of the patient, the phone number of the user, and the NDC number of a medication (Fig. 3A1-3B2, par. 38-39 and 43-48). The remainder of claim 60 repeats the same limitations as claims 56-59, and is therefore rejected for the same reasons given for those claims.

(D) Claim 64 differs from claims 56-60 by reciting "wherein said at least one of said pharmacist and said personnel and said filling pharmacy are remotely located from each other, and remotely located from said prescription processing system."

Firstly, it is noted that the definition of "remote" with regards to computer science means located at a distance from another computer that is accessible by cables or other communications links. Secondly, as per this recitation, Albaum discloses in Figure 1 the POETRY system, wherein a user interface 20 (reads on "personnel") is connected to a

POETRY SYSTEMS Interactive medication ordering system 15 (reads on "prescription processing system") which is connected to a pre-existing hospital pharmacy system 12, retail pharmacy, outpatient/clinic pharmacy 174, or other off-site location 176 (reads on "filling pharmacy"). Further, Albaum discloses bi-directional interaction and direct transmission via modem or fax units between the aforementioned off-site components in Figure 1 (col. 15 lines 10-50). Thus, it is the position of the Examiner that Albaum teaches or suggests the limitation "wherein said at least one of said pharmacist and said personnel and said filling pharmacy are remotely located from each other, and remotely located from said prescription processing system."

(E) Claim 65 differs from claims 56- 60 and 64 by reciting "independently assessing by at least one of a pharmacist and personnel associated with the prescription processing system correctness of the prescription request, the at least one of the pharmacist and personnel and the prescription processing system being separate from at least one of a hospital and a physician where the prescription request was originated, and the at least one of the pharmacist and personnel and the prescription processing system being separate from a central pharmacy where the prescription request is to be filled."

As per this recitation, firstly, it is noted that the definition of "remote" with regards to computer science means located at a distance from another computer that is accessible by cables or other communications links. Secondly, Albaum discloses in Figure 1 the POETRY system, wherein a user interface 20 (reads on "personnel") is connected to a POETRY SYSTEMS Interactive medication ordering system 15 (reads

on "prescription processing system") which is connected to a pre-existing hospital pharmacy system 12, retail pharmacy, outpatient/clinic pharmacy 174, or other off-site location 176 (reads on "filling pharmacy"). Further, Albaum discloses bi-directional interaction and direct transmission via modem or fax units between the aforementioned off-site components in Figure 1 (col. 15 lines 10-50). Further, Albaum discloses the POETRY SYSTEMS Interactive medication ordering system 15 (reads on "prescription processing system") being connected bi-directionally to a pre-existing hospital system (reads on "the at least one of the pharmacist and personnel and the prescription processing system being separate from at least one of a hospital and a physician where the prescription request was originated") and the user interface and POETRY SYSTEMS Interactive medication ordering system 15 being separate from retail pharmacies (the at least one of the pharmacist and personnel and the prescription processing system being separate from a central pharmacy where the prescription request is to be filled") (Figure 1).

The remainder of claim 65 recites the same limitations as claims 56-60 and 64, and is therefore rejected for the same reasons given above for those claims, and incorporated herein.

15. Claims 61 and 62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albaum et al. (5,758,095) in view of Walker et al. (5,883,370) and Munoz et al. (US 2002/0052760). It is noted that these newly added claims appear to be combinations of limitations that were presented in independent claims 1 and 37-43 and dependent

claims 2-36 and 44-53, and newly added claims 54-55, 63, and 66. These limitations were addressed in the previous Office Action (paper number 5) and in the rejections of claims 1-53 and newly added claims 54-55, 63, and 66 above, and are incorporated herein.

(A) As per claim 61, Albaum discloses a method for prescribing medication for a patient comprising (col. 20 lines 40-43):

(a) signing onto a hospital pharmacy module or an outpatient/clinic module of an interactive medication ordering system by entering a user's ID (sign-on code) through a user interface over a communication network, wherein the user interface is used to communicate with an off-site location through the interactive medication ordering system (reads on "remotely"), wherein a screen as seen in Figure 28 is provided for initiation of an order for medications (Fig. 1, 28, and 49a, col. 1 lines 5-13, col. 4 lines 52-55, col. 6 line 23 to col. 4 line 30, col. 16 lines 10-20, col. 17 lines 40-60);

(b) entering a new order for a prescription using voice entry, wherein the order includes information related to at least one medication identifier, the patient's name, the patient's bed number, the patient's medical record number, the maximum dosage recommended for a patient (Fig. 49c, 49i, col. 3 lines 1-3, col. 6 lines 34-40, col. 7 line 65 to col. 8 line 11, col. 20 line 40 to col. 21 line 33); and

(c) directly transmitting all completed prescription(s) to a designated outpatient, clinic, or retail pharmacy (reads on "remotely located... pharmacy") after the order is entered (col. 15 lines 12-48).

It is noted the Albaum discloses the order being entered and then directly transmitting the order to a designated pharmacy, and it is respectfully submitted that this designated pharmacy is a form of "predetermined pharmacy."

Albaum and Walker do not expressly disclose establishing a connection using a telephone and submitting an audible prescription request using a telephone. However, Albaum suggest using voice recognition to input data (col. 7 lines 25-30) (reads on "audible prescription request". Note the discussion above at step c.

Munoz discloses an IVR (interactive voice response) system for detecting incoming telephone calls, answering the telephone call, and providing the caller with various input prompts, wherein the system is utilized for creating a prescription requests and refills (Fig. 1, par. 38-39, par. 43-48, page 8 claims 1-5).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the telephonic features of Munoz within the method taught collectively by Albaum and Walker with the motivation of allowing a user to quickly interact with a prescription system by the system automatically answering the telephone call and beginning to interact with the user (Munoz; par. 4) and to provide a system for users who may not have a computer to input information, thus increasing the number of users of the system.

As per the limitations of retrieving by the patient a filled prescription from a predetermined filling pharmacy, note the obviousness of such a feature in light of the collective teachings of Albaum and Walker, given above in the rejection of claims 56-60 and 64, and incorporated herein.

The remainder of claim 61 repeats the same limitations as claims 56-60 and 64, and is rejected for the same reasons given for those claims, and incorporated herein.

(B) As per claim 62, Albaum discloses a method for prescribing medication for a patient comprising (col. 20 lines 40-43):

signing onto a hospital pharmacy module or an outpatient/clinic module of an interactive medication ordering system by entering a user's ID (sign-on code) through a user interface over a communication network, wherein the user interface is used to communicate with an off-site location through the interactive medication ordering system (reads on "remotely"), wherein a screen as seen in Figure 28 is provided for initiation of an order for medications (Fig. 1, 28, and 49a, col. 1 lines 5-13, col. 4 lines 52-55, col. 6 line 23 to col. 4 line 30, col. 16 lines 10-20, col. 17 lines 40-60).

The remainder of claim 62 repeats the same limitations as claims 61, and is rejected for the same reasons given for those claims, and incorporated herein.

16. Claims 67-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Albaum et al. (5,758,095) in view of Walker et al. (5,883,370), Munoz et al. (US 2002/0052760), Simcox (5,992,890), and Bartur (6,263,259). It is noted that these newly added claims appear to be combinations of limitations that were presented in independent claims 1 and 37-43 and dependent claims 2-36 and 44-53, and newly added claims 54-55, 63, and 66. These limitations were addressed in the previous

Office Action (paper number 5) and in the rejections of claims 1-53 and newly added claims 54-55, 63, and 66 above, and are incorporated herein.

(A) As per claims 67-69, Albaum discloses a method for prescribing medication for a patient comprising (col. 20 lines 40-43):

(a) signing onto a hospital pharmacy module or an outpatient/clinic module of an interactive medication ordering system by entering a user's ID (sign-on code) through a user interface over a communication network, wherein the user interface is used to communicate with an off-site location through the interactive medication ordering system (reads on "remotely") (Fig. 1 and 49a, col. 1 lines 5-13, col. 6 line 23 to col. 4 line 30, col. 16 lines 10-20, col. 17 lines 40-60);

(b) entering a new order for a prescription using voice entry, wherein the order includes information related to at least one medication identifier, the patient's name, the patient's bed number, the patient's medical record number, the maximum dosage recommended for a patient, wherein orders are communicated to the interactive medication ordering system and pharmacy using facsimile and modem (Fig. 1, col. 6 lines 23-55, col. 15 lines 11-32) and (Fig. 49c, 49i, col. 3 lines 1-3, col. 6 lines 34-40, col. 7 line 65 to col. 8 line 11, col. 20 line 40 to col. 21 line 33);

(c) performing an order recognition function by an order reformatter and interpreter to check for recognition of the doses, route of administration, frequency, and duration, wherein the order information received by the order reformatter and interpreter when entered by the user is entered in random sequence and then processed, wherein

the inpatient module performs processing functions and is connected to the user interface which accepts input via keyboard and mouse, voice recognition, or pen interface (reads on "capturing..." and "converting...") (Fig. 49e and 49f, col. 7 lines 25-30, col. 11 lines 4-13, col. 20 line 40 to col. 21 line 33);

(d) providing a database containing health and medication information regarding a patient, wherein the information is stored as patient records, wherein a patient record includes information such as medication ordered, dosage, frequency, medication quantity and formulary, wherein a user may edit a current or active medication order, wherein a patient's medication profile contains the patient's name, bed number, medical record number, list of patient's current schedule and PRN medications (Fig. 33, col. 8 lines 12-20, col. 10 lines 17-60, col. 17 lines 15-35, col. 18 lines 63-67, col. 20 line 40 to col. 21 line 33);

(e) interpreting and reformatting the orders for processing (reads on "transcribing...") (col. 3 lines 15-20); and

(f) automatically transmitting and printing in the pharmacy the written or typed order by a physician based on the interpreted and reformatted orders, wherein the physician is able to electronically counter sign the patient's order and is alerted to potentially adverse situations such as drug reactions, wherein the pharmacy is a pre-existing hospital pharmacy (reads on "central pharmacy" or "filling pharmacy") or retail pharmacy (reads on "filling pharmacy") (reads on "preparing..." and "sending...") (Fig. 1, col. 3 lines 15-20, col. 7 lines 25-40, col. 8 lines 43-63, col. 15 lines 12-32, col. 18 lines 1-6, col. 20 line 40 to col. 21 line 45).

Albaum fails to expressly disclose sending "a completed prescription form" to a central pharmacy, and then filling the prescription request at the central pharmacy, based at least partially on the completed prescription form.

Walker includes printing out a prescription slip (Fig. 6) with a prescription bar code which contains pertinent prescription information to enable filling of the prescription, taking the prescription slip to a pharmacist by the patient, and having the pharmacist fill the prescription by scanning the prescription bar code on the prescription slip to obtain the pertinent information (Figure 3, col. 5 line 55 to col. 6 line 7).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the aforementioned components with the method of Albaum with the motivation of reducing the time from when the order is written to when it is received in the pharmacy (Albaum; col. 1 lines 30-36), reducing the efficiencies due to slow and cumbersome medication ordering paths by reducing the paperwork and task duplication (Albaum; col. 1 line 63 to col. 2 line 10), providing a system which is less rigid and easier to use for physicians (col. 2 line 45-50), and reducing the number of errors in prescribing medications (Walker; col. 1 lines 25-30).

In addition, it is noted that Albaum's database stores patient medical information including patient medications as patient records, wherein the medications are entered in the patient medication profile (Fig. 33, col. 8 lines 12-20, col. 10 lines 17-60, col. 17 lines 15-35, col. 18 lines 63-67, col. 20 line 40 to col. 21 line 33). Therefore, Albaum's entering of information in a database is considered to be a form of associating or concatenating "an identification file" with "a prescription file."

Albaum and Walker do not expressly disclose establishing a connection using a telephone and submitting an audible prescription request using a telephone. However, Albaum suggest using voice recognition to input data (col. 7 lines 25-30) (reads on “audible prescription request”. Note the discussion above at step c.

Munoz discloses an IVR (interactive voice response) system for detecting incoming telephone calls, answering the telephone call, and providing the caller with various input prompts, wherein the caller provides input by pressing buttons on a DTMF telephone during the call, and wherein the system is utilized for creating a prescription requests and refills (Fig. 1, par. 38-39, par. 43-48, page 8 claims 1-5). Munoz also discloses faxing in a prescription request (Abstract; par. 2-4).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the telephonic features of Munoz within the method taught collectively by Albaum and Walker with the motivation of allowing a user to quickly interact with a prescription system by the system automatically answering the telephone call and beginning to interact with the user (Munoz; par. 4) and to provide a system for users who may not have a computer to input information, thus increasing the number of users of the system.

The collective teachings of Albaum, Walker, and Munoz fail to expressly disclose “independently assessing by personnel associated with the prescription processing system correctness of the prescription request”. However, such a feature is suggested by Albaum by the disclosure of requiring a physician to countersign orders electronically and upon sending a prescription refill, having the authorization for the prescription

verified (col. 15 lines 33-49, col. 18 lines 1-6). It is noted that typically “countersigning” an order for a prescription would include the physician viewing the order to determine whether or not it is a proper order before the physician signs the order.

Simcox discloses system where a prescriber transmits a prescription to a computer either within the prescribers office or at the point of pharmaceutical distribution (col. 4 lines 21-40 and col. 5 lines 1-25). Further Simcox discloses upon a pharmacist receiving the completed prescription, the pharmacist interpreting the pharmaceutical identification and confirming this interpretation by correlating the specific pharmaceutical identified in the pharmaceutical identification section with the application being identified in a graphical indicia section, and then in the event that the pharmaceutical identified does not serve the purpose illustrated by the selected graphical icon, the pharmacist immediately knows that the pharmaceutical is incorrect, wherein the graphical icons are classes of pharmaceuticals such as Cough/Cold, respiratory/lung disorders, etc.) (col. 3 line 65 to col. 4 line 8, col. 4 lines 21-40 and col. 5 lines 1-25).

At the time the invention was made, it would have been obvious to combine the features of Simcox within the method taught collectively by Albaum, Walker, and Munoz with the motivation of preventing a pharmaceutical from being dispensed that is incorrect, thus preventing a potentially dangerous situation for a patient (Simcox; col. 4 lines 21-40).

Claims 67-69 include the step of comparing “at the prescription processing system” a physician’s phone number and a prescription number, and if the physician’s

phone number and the prescription number result in a predetermined relationship, “wherein the predetermined relationship is a match between the physician’s phone number and the prescription number and a stored physician’s phone number and a stored prescription number stored at the prescription processing system” then filling the prescription request using an automated entry agent “associated with the prescription processing system”.

Albaum, Walker, Munoz, and Simcox fail to expressly disclose these newly added limitations.

However, Albaum suggests the step of verifying who a user’s identity by disclosing an inpatient module performing all of the primary processing function represented by the order reformatter and interpreter (col. 7 lines 25-30) and requiring a physician to countersign orders electronically and upon sending a prescription refill, having the authorization for the prescription verified (col. 15 lines 33-49, col. 18 lines 1-6).

Bartur discloses verifying by a database a patient ID, physician ID, and medication ID by matching the patient ID, physician ID, and medication ID with stored IDs in the database, wherein if the IDs are verified, the prescription is dispensed by a medication unit dispensing stored medications (Abstract; col. 11 lines 30-50, col. 13 line 49 to col. 14 line 44).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the features of Bartur within the method taught collectively by Albaum, Walker, Munoz, and Simcox with the motivation of preventing a

pharmaceutical from being dispensed that is incorrect, thus preventing a potentially dangerous situation for a patient (Simcox; col. 4 lines 21-40).

As per the recitation of a “physician’s phone number”, it is noted that Bartur’s Physician ID may include a physician’s phone number as the ID. It would have been obvious within the method taught collectively by Albaum, Walker, Munoz, Simcox, and Bartur to include using a phone number with the motivation of providing a physician with an identifier that is easy to remember.

As per the recitation of “converting the digitized prescription request to a digitized format to obtain a digitized prescription request,” Albaum discloses performing an order recognition function by an order reformatter and interpreter to check for recognition of the doses, route of administration, frequency, and duration, wherein the order information received by the order reformatter and interpreter when entered by the user is entered in random sequence and then processed, wherein the inpatient module (reads on “prescription processing system”) performs processing functions and is connected to a user interface which accepts input via keyboard and mouse, voice recognition, or pen interface (reads on “capturing...” and “converting...”) (Fig. 49e and 49f, col. 7 lines 25-30, col. 11 lines 4-13, col. 20 line 40 to col. 21 line 33). Further, Albaum discloses the inpatient module performing all of the primary processing function represented by the order reformatter and interpreter, including voice recognition, which would include converting voice to digital data (col. 7 lines 25-30).

Claims 67-69 recite “independently assessing by at least one of a pharmacist and personnel associated with the prescription processing system correctness of the

prescription request, the at least one of the pharmacist and personnel and the prescription processing system being separate from at least one of a hospital and a physician where the prescription request was originated, and the at least one of the pharmacist and personnel and the prescription processing system being separate from a central pharmacy where the prescription request is to be filled.”

As per this recitation, firstly, it is noted that the definition of “remote” with regards to computer science means located at a distance from another computer that is accessible by cables or other communications links. Secondly, Albaum discloses in Figure 1 the POETRY system, wherein a user interface 20 (reads on “personnel”) is connected to a POETRY SYSTEMS Interactive medication ordering system 15 (reads on “prescription processing system”) which is connected to a pre-existing hospital pharmacy system 12, retail pharmacy, outpatient/clinic pharmacy 174, or other off-site location 176 (reads on “filling pharmacy”). Further, Albaum discloses bi-directional interaction and direct transmission via modem or fax units between the aforementioned off-site components in Figure 1 (col. 15 lines 10-50). Further, Albaum discloses the POETRY SYSTEMS Interactive medication ordering system 15 (reads on “prescription processing system”) being connected bi-directionally to a pre-existing hospital system (reads on “the at least one of the pharmacist and personnel and the prescription processing system being separate from at least one of a hospital and a physician where the prescription request was originated”) and the user interface and POETRY SYSTEMS Interactive medication ordering system 15 being separate from retail pharmacies (the at least one of the pharmacist and personnel and the prescription

processing system being separate from a central pharmacy where the prescription request is to be filled”) (Figure 1).

Response to Arguments

17. Applicant's arguments with respect to claims 1, 9, 18, 27, 28, 29, 37, 38, 39, 40 46, 54-55 and 66 have been considered but are moot in view of the new ground(s) of rejection.

18. Applicant's arguments filed 19 August 2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the response filed 19 August 2003.

(A) At pages 25-27 of the response filed 19 August 2003, Applicant argues that the applied prior art fails to teach the following limitation within claim 1: “establishing a connection to a remotely located prescription processing system.”

In response, the Examiner respectfully submits that neither of the Albaum, Walker, and/or Simcox references were ever applied as references under 35 U.S.C. 102 against the pending claims. As such, the Examiner respectfully submits the issue at hand is not whether the applied prior art specifically teaches “establishing a connection to a remotely located prescription processing system”, *per se*, but rather whether or not the prior art, when taken in combination with the knowledge of average skill in the art, would put the artisan in possession of this feature. Regarding this issue, it is well

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established that references are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969). The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)).

Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would suggest.

According to *In re Jacoby*, 135 USPQ 317 (CCPA 1962), the skilled artisan is presumed to know something more about the art than only what is disclosed in the applied references. In *In re Bode*, 193 USPQ 12 (CCPA 1977), every reference relies to some extent on knowledge of persons skilled in the art to complement that which is disclosed therein.

According to *Ex parte Berins*, 168 USPQ 374 (Bd. Appeals), there is no statutory limitation as to the number of references that may be used to demonstrate obviousness...not what references expressly state but what they would reasonably suggest to one of ordinary skill in the art. In *In re Conrad*, 169 USPQ 170 (CCPA),

obviousness is not based on express suggestion, but what references taken collectively would suggest.

In this case, Albaum discloses signing onto a hospital pharmacy module or an outpatient/clinic module of an interactive medication ordering system by entering a user's ID (sign-on code) through a user interface over a communication network, wherein the user interface is used to communicate with an off-site location through the interactive medication ordering system (reads on "remotely") (Fig. 1 and 49a, col. 1 lines 5-13, col. 6 line 23 to col. 4 line 30, col. 16 lines 10-20, col. 17 lines 40-60). In addition, it is noted that the definition of "remote" with regards to computer science means located at a distance from another computer that is accessible by cables or other communications links. As discussed above, Albaum discloses in Figure 1 the POETRY system, wherein a user interface 20 is connected to a POETRY SYSTEMS Interactive medication ordering system 15 (reads on "prescription processing system") which is connected to a pre-existing hospital pharmacy system 12, retail pharmacy, outpatient/clinic pharmacy 174, or other off-site location 176 (reads on "filling pharmacy"). Further, Albaum discloses bi-directional interaction and direct transmission via modem or fax units between the aforementioned off-site components in Figure 1 (col. 15 lines 10-50). Further, Albaum discloses the POETRY SYSTEMS Interactive medication ordering system 15 (reads on "prescription processing system") being connected bi-directionally to a pre-existing hospital system and the user interface and POETRY SYSTEMS Interactive medication ordering system 15 being separate from retail pharmacies. It is the position of the Examiner that the skilled artisan would be in

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possession of the step of "establishing a connection to a remotely located prescription processing system", such as that claimed in the amendment filed 19 August 2003, when considering the teachings of Albaum, Walker, and/or Simcox collectively, in combination with the knowledge of average skill in the art.

As such, it is respectfully submitted that Applicant appears to view the applied references in a vacuum without considering the knowledge of average skill in the art.

With respect to the limitations recently added to the claims in the amendment filed 7 November 2003, the Examiner respectfully submits that all features present claimed in claim 1 are disclosed by the collective teachings of the Albaum, Walker, and/or Simcox references as discussed in detail in section 9A in addition to the reasons set forth in the previous Office Action (paper number 5), and incorporated herein.

(B) At pages 28 and 29 of the response filed 19 August 2003, Applicant argues that the applied prior art fails to teach the features of claims 3-4.

In response, the Examiner respectfully submits that Albaum discloses submitting prescriptions via keyboard and mouse, voice recognition, pen (Figure 1) or a fax unit to transmit prescriptions (col. 15 lines 10-35). It is the position of the Examiner that the skilled artisan would be in possession of a system or method including submitting prescriptions based on faxing or electronic mail, when considering the teachings of Albaum, Walker, and/or Simcox collectively, in combination with the knowledge of average skill in the art, for at least the reason of increasing the ease of use and thus user friendliness (Albaum; col. 2 lines 42-62, col. 6 lines 23-55).

As such, it is respectfully submitted that Applicant appears to view the applied references in a vacuum without considering the knowledge of average skill in the art.

(C) Applicant's remaining arguments given at pages 33-52, namely to claims 37-46 and 49-53 of the response filed 19 August 2003 rely upon, rehash the issues addressed above, or reflect claims that have been amended in the response filed 7 November 2003, and are therefore moot in view of the responses given in sections 18(A)-18(B) above and rejections given in the present Office Action, and incorporated herein.

(D) At pages 47-48 of the response filed 19 August 2003, Applicant argues that the applied prior art fails to teach the features of claims 47-49.

In response, the Examiner respectfully submits that Albaum and Walker taken collectively teach communicating over a communications network, wherein a modem unit will process and transmit all complete prescriptions to designated outpatient, clinic, or retail pharmacies (Walker; Fig. 1, col. 2 line 65 to col. 3 line 50, col. 6 line 23 to col. 7 line 23, col. 15 lines 12- 48). It is the position of the Examiner that the skilled artisan would be in possession of a system or method including a public network, private network, or the Internet, when considering the teachings of Albaum, Walker, and/or Simcox collectively, in combination with the knowledge of average skill in the art, for at least the reason of provide access from remote locations quickly by reducing the speed and difficulty in accessing information or to ensure the privacy of confidential information.

As such, it is respectfully submitted that Applicant appears to view the applied references in a vacuum without considering the knowledge of average skill in the art.

19. Applicant's arguments filed 7 November 2003 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the response filed 7 November 2003.

(A) At pages 31-42 of the response filed 7 November 2003, Applicant argues that certain features of claims 1, 9, 18, 27, 28, 29, 37, 38, 39, 40, and 46 are not taught by the applied references.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 7 November 2003 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Albaum, Walker, Munoz, Simcox, Bartur, Johnson, and/or Rhodes based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 5), and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, it is respectfully submitted that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

(B) At pages 32-33 of the 7 November 2003 response, Applicant argues that the features of claim 7 are not taught by the applied references.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a digitized prescription request is transcribed such that general information is transcribed into a printable or file format or other format, personnel transcribes prescription-related information in the digitized prescription request to prepare a completed prescription form, a prescription request can be received in a number of ways, including, for example, from a physician's computer, from a telephone, from e-mail, from facsimile, and from wireless/mobile transmission devices, and transcribing would include speech, into text) are not recited in the rejected claim 7. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, the Applicant appears to argue that the claimed "transcribing" step has been defined throughout the specification. In response, it is respectfully submitted that the specification citations relied upon by the Applicant do not provide a positive definition of the claimed "transcribing" step. Instead, the cited passages use non-committal language that only describes the features which "can be" included in the claimed "transcribing" step in various embodiments. Such descriptions fail to define the required features of the "transcribing" step. As such, the Examiner has given the claim language the broadest interpretation and has applied art accordingly.

(C) At page 39 of the 7 November 2003 response, Applicant argues that the prior art fails to teach the step of "terminating the connection if the user would not like to submit a new prescription request." Further, the Applicant appears to argue that the claimed "terminating" step has been defined throughout the specification.

In response, it is respectfully submitted that the specification citations relied upon by the Applicant state the following: "The process subsequently ends. Additionally if the user will not submit an additional prescription request at step S76, then the process also ends." The Examiner cited the following passage from Albaum as teaching the "terminating" step: closing the ordering screen and beginning order processing if the user has completed the orders (Fig. 29, col. 13 lines 44-54). It appears that the passages cited from Albaum clearly disclose the step of "terminating" as recited in claim 39 when taken in view with the Applicant's specification citations. Note, Albaum's

teachings of “closing the ordering screen” (i.e., ending a process) and “beginning order processing” (i.e. starting a new process).

Furthermore, it is respectfully submitted that claim 39 does not recite “terminating the connection...” from the prescription processing system or another system component. If the Applicant wishes to recite “terminating” from a component within the system, the Applicant should amend the claims to include this feature.

Conclusion

20. The prior art made of record and not relied upon is considered pertinent to Applicant’s disclosure. The cited but not applied prior art teaches an automated medical prescription fulfillment system (5,597,995), method and apparatus for document verification and tracking (5,671,282), automatic prescription filling, sorting, and packaging system (5,771,657), medication dispensing and monitoring system (6,004,020), computer implemented patient medication review system and process (6,014,631), system and method for vending prescription medications (6,330,491), remote prescription refill system (6,493,427), automatic prescription drug dispenser (6,529,801), systems and methods for drug dispensing (6,564,121), interactive telephony system (6,680,999), network-based information management system for the creation, production, fulfillment, and delivery of prescription medications and other complex products and services (Mohsen), CVS and Merck-Medco form strategic alliance (Business Wire), and pharmaceutical distribution (Oswald).

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

23. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]

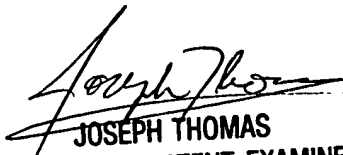
(703) 746-8374 [Informal/ Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).



CB

January 24, 2004



JOSEPH THOMAS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600